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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/000,366	01/28/98	HOASHI M	HOASHI=2

001444 IM22/0424
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EXAMINER	
BECKER, D	
ART UNIT	**PAPER NUMBER**
1761	17

DATE MAILED: 04/24/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/000,366	Applicant(s) Hoashi et al
	Examiner Drew Becker	Group Art Unit 1761

☒ Responsive to communication(s) filed on *Mar 17, 2000*.

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1 and 3-12* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1 and 3-12* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Continued Prosecution Application

1. The request filed on March 17, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/000,366 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The term "of the type" in claim 7 is a relative term which renders the claim indefinite. The term "of the type" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what particular feature is being referred to.

5. The term "and/or" in claim 7 is a relative term which renders the claim indefinite. The term "and/or" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It not clear how a pin mixer can be of the type of shown in Figure 1 and JP 3-41145B, while also being of the type used by one and not the other.

6. Claim 7 is rejected for containing reference to a foreign patent (JP 3-41145B) on line 9 of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1, 3-7, and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katoh et al in view of JP 60-70049.

Katoh et al teach the concepts of thawing and milling frozen surimi into pieces of between 3.0 and 10 mm in size (column 7, lines 1-4), mixing in additives with a pin mixer (column 7, line 10; Figure 1), forming kamaboko (column 7, line 17), and the additives being seasoning, starch,

mirin, and water (column 7, lines 1-6) . It would have been obvious to one of ordinary skill in the art to thaw the fish of Katoh et al without mashing since thawing by simply leaving a frozen product in a warmer environment is a commonly known method of thawing. Katoh et al do not explicitly teach the concept of first freezing followed by grinding of the fish meats. JP 60-70049 teaches the concept of grinding already frozen fish meats into particles (claim) by use of a cutter (page 3, lines 24-30). It would have been obvious to one of ordinary skill in the art to incorporate the freezing then milling method of JP 60-70049 into the method of Katoh et al since Katoh et al already include the steps of crushing and freezing but not explicitly in the order of JP 60-70049 and thawing after size reduction takes less time because the decreased thickness of the fish aids heat transfer. It would have been obvious to one of ordinary skill in the art to combine the cutter of JP 60-70049 with the uniform milling of Katoh et al since a more gradual size reduction process by use of a cutter would be beneficial to the service life of the milling machinery.

9. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katoh et al and JP 60-70049 in view of JP 06-133739.

Katoh et al and JP 60-70049 teach the concepts mentioned above. Katoh et al also teach the concepts of producing kamaboko by molding the ground fish (column 6, line 52), heating the ground fish while in the mold for network formation (column 6, line 60), and further heating (column 6, line 62). Katoh et al and JP 60-70049 do not teach the concept of heating the fish paste by passing electric current through the fish. JP 06-133739 teaches the concept of heating

fish by passing electric current through it (Constitution). It would have been obvious to one of ordinary skill in the art to incorporate the electric heating of JP 06-133739 into the method of Katoh et al and JP 60-70049 since ohmic heating is a commonly known method of heating and does not require a heating medium, such as oil or steam, to contact the food.

Response to Arguments

10. Applicant's arguments filed March 17, 2000 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The combined teachings of Katoh et al and JP 60-70049 produce the rejection relied upon in this and previous office actions. Katoh et al teaches the known method of thawing and milling frozen surimi, combining with additives in a pin mixer, and producing kamaboko while JP 60-70049 teaches the known method of first milling frozen fish before thawing and the improved quality produced (page 2, final paragraph; page 7, lines 16-20).

Conclusion

11. This is a continuation of applicant's earlier Application No. 09/000,366. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew Becker whose telephone number is (703)-305-0300. The examiner can normally be reached on Monday-Thursday from 7:00 am to 4:00 pm and every other Friday from 7:00 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gabrielle Brouillette, can be reached on (703)-308-0756. The fax number for this Group is (703)-305-3602.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0651.

Drew Becker

April 20, 2000

KEITH HENDRICKS
PRIMARY EXAMINER